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| 09/776,990  | 02/05/2001  | Stephen J. Boies     | YOR920000759US1     | 4937             |
| 35526   | 7590        | 07/23/2004           | EXAMINER            |                  |
| DUKE. W. YEE<br>YEE & ASSOCIATES, P.C.<br>P.O. BOX 802333<br>DALLAS, TX 75380 |             |                      | GART, MATTHEW S     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3625                |                  |

DATE MAILED: 07/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/776,990

Applicant(s)

BOIES ET AL.

Examiner

Matthew s Gart

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) 1-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 1-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant's election with traverse of claims 45-66 in the reply filed on 4/22/2004 is acknowledged.

The traversal is on the ground(s) that the search and examination of the entire application can be made without a serious burden to the examiner. This is not found persuasive because a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of a different field of search as defined in MPEP § 808.02.

In the instant application, Inventions I and II (or III) are related as process and apparatus (or product) for its practice. In this case the process of Group I can be practiced by hand. It is noted that claim 1, for example, requires no system (or product) implemented in performance of the method. Accordingly, the product of Group III would require a search not necessary and more extensive than that of Group I. With reference to Group II, the specifics of the product recited in Group III are not relied upon in integration with the system of Group II and thus would require a different search.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 45-59 and 65-66 are rejected under 35 U.S.C. 102(e) as being anticipated by Hennig U.S. Patent No. 6,587,827.**

Referring to claim 45. Hennig discloses a computer program product for decentralized order matching among a plurality of separate, individual marketplaces, said computer program product comprising:

- Instruction means for receiving an order within a first one of said plurality of different individual marketplaces (Hennig: column 2, lines 28-40);
- Instruction means for transmitting information about said received order to other ones of said plurality of marketplaces (Hennig: column 2, lines 28-40);
- Instruction means for determining, within each of said other ones of said plurality of marketplaces which received said information about said received order, whether said other one of said plurality of marketplaces can match said received order with at least one matching order posted in a local order book maintained by said other one of said plurality of marketplaces (Hennig: column 5, line 64 to column 6, line 3); and

- Instruction means for in response to a determination that said other one of said plurality of marketplaces can match said received order, clearing said received order from said first one of said plurality of marketplaces and said at least one matching order posted in said local order book maintained by said other one of said plurality of marketplaces (Hennig: column 5, line 64 to column 6, line 3).

Referring to claim 46. Hennig further discloses a product comprising instruction means for prior to transmitting said information about said received order to other ones of said plurality of marketplaces, locking said received order in said first one of said plurality of marketplaces, wherein said received order cannot be modified while said received order is locked (Hennig: column 34-46).

Referring to claim 47. Hennig further discloses a product comprising:

- Instruction means for specifying a plurality of preferred ones of said plurality of marketplaces (Hennig: column 5, line 49 to column 6, line14);
- Instruction means for transmitting information about said received order first to only said plurality of preferred ones of said plurality of marketplaces (Hennig: column 5, line 49 to column 6, line14);
- Instruction means for determining whether any of said plurality of preferred ones of said plurality of marketplaces can match said received order with at least one matching order posted in a local order book maintained by one of said plurality of preferred ones of said plurality of marketplaces (Hennig: column 5, line 49 to column 6, line14); and

- Instruction means for in response to a determination that at least one of said plurality of preferred ones of said plurality of marketplace can match said received order, clearing said received order from said first one of said plurality of marketplaces and said at least one matching order posted in said local order book maintained by said at least one of said plurality of preferred ones of said plurality of marketplaces (Hennig: column 5, line 49 to column 6, line14).

Referring to claim 48. Hennig further discloses a product comprising instruction means for in response to a determination that none of said plurality of preferred ones of said plurality of marketplaces can match said received order, transmitting said received order to ones of said plurality of marketplaces which are not said plurality of preferred ones of said plurality of marketplaces (Hennig: column 3, lines 30-46, "A client computer is connected to a network server via the network, and the server also communicated with a plurality of supplier computers (preferred suppliers) and a supplier hub (non-preferred suppliers) through the network.").

Referring to claim 49. Hennig further discloses a product comprising:

- Instruction means for determining, within a plurality of said other ones of said plurality of marketplaces which received said received order, that said plurality of said other ones of said plurality of marketplaces can match said received order with a matching order posted in a local order book maintained by each of said plurality of said other ones of said plurality of marketplaces (Hennig: column 5, line 64 to column 6, line 3);

- Instruction means for receiving, within said first one of said plurality of marketplaces, information about a plurality of matching orders, said plurality of matching orders including information about said matching order posted in said local order book maintained by each of said plurality of said other ones of said plurality of marketplaces (Hennig: column 5, line 64 to column 6, line 3); and
- Instruction means for selecting a best order from said plurality of matching orders (Hennig: column 5, line 64 to column 6, line 3).

Referring to claim 50. Hennig further discloses a product comprising instruction means for screening orders from non-approved ones of said plurality of marketplaces, wherein orders from non-approved marketplaces are not included in said plurality of matching orders (Hennig: column 7, lines 17-34).

Referring to claim 51. Hennig further discloses a product comprising instruction means for transmitting a notice to one of said plurality of marketplaces where said best order is posted (Hennig: claim 1, "...determining said first preferred supplier having an inventory of available product that is favorably geographically located to minimize the time and expense of shipment of the product to the customer.")

Referring to claim 52. Hennig further discloses a product comprising instruction means for receiving a confirmation from said one of said plurality of marketplaces where said best order is posted that said best order has been cleared from a local order book maintained by said one of said plurality of marketplaces where said best order is posted (Hennig: Figure 2, Figure 3 and Figure 4).

Referring to claim 53. Hennig further discloses a product comprising instruction means for clearing said received order from said first one of said plurality of marketplaces only in response to a receipt of said confirmation (Hennig: Figure 2, Figure 3 and Figure 4).

Referring to claim 54. Hennig further discloses a product comprising instruction means for unlocking said received order in said first one of said plurality of marketplaces in response to a receipt of said confirmation (Hennig: Figure 2, Figure 3 and Figure 4).

Referring to claim 55. Hennig further discloses a product comprising instruction means for unlocking said received order in said first one of said plurality of marketplaces in response to a determination that none of said other ones of said plurality of marketplaces can match said received order (Hennig: Figure 2, Figure 3 and Figure 4).

Receiving to claim 56. Hennig further discloses a product comprising:

- Instruction means for receiving a notice from said one of said plurality of marketplaces where said best order is posted that said best order cannot be cleared from a local order book maintained by said one of said plurality of marketplaces where said best order is posted (Hennig: column 5, line 64 to column 6, line 3);
- Instruction means for removing said best order from plurality of matching orders (Hennig: column 5, line 64 to column 6, line 3); and



- Instruction means for selecting another order from remaining ones of said plurality of matching orders (Hennig: column 5, line 64 to column 6, line 3).

Referring to claim 57. Hennig further discloses a product comprising:

- Instruction means for in response to a second one of said plurality of marketplaces receiving said information about said received order from said first one of said plurality of marketplaces, said second one determining whether said second one can match said received order with at least one order posted in a local order book maintained by said second one of said plurality of marketplaces (Hennig: Figure 2, Figure 3 and Figure 4); and
- Instruction means for in response to a determination that said second one of said plurality of marketplaces cannot match said received order, said second one of said plurality of marketplaces transmitting a notice to said first one of said plurality of marketplaces that no match exists (Hennig: Figure 2, Figure 3 and Figure 4).

Referring to claim 58. Hennig further discloses a product comprising:

- Instruction means for in response to a second one of said plurality of marketplaces receiving said information about said received order from said first one of said plurality of marketplaces, said second one determining whether said second one can match said received order with at least one order posted in a local order book maintained by said second one of said plurality of marketplaces (Hennig: Figure 2, Figure 3 and Figure 4); and

- Instruction means for in response to a determination that said second one of said plurality of marketplaces can match said received order, said second one selecting all orders posted in said second one's local order book which match a product requested by said received order (Hennig: Figure 2, Figure 3 and Figure 4);
- Instruction means for said second one locking all of said selected orders (Hennig: Figure 2, Figure 3 and Figure 4); and
- Instruction means for said second one transmitting a notice to said first one, said notice including information about all of said selected orders (Hennig: Figure 2, Figure 3 and Figure 4).

Referring to claim 59. Hennig further discloses a product comprising:

- Instruction means for said first one transmitting a specification of at least one of said selected orders to said second one (Hennig: claim 1);
- Instruction means in response to said second one has receiving a specification from said first one of said at least one of said selected orders (Hennig: claim 1):
  - For unlocking all of said selected orders (Hennig: claim 1);
  - For cleaning said at least one of said selected orders specified by said first one (Hennig: claim 1); and
  - For said second one transmitting a confirmation to said first one that said at least one of said selected orders has been cleared (Hennig: claim 1).

Receiving to claim 65. Hennig further discloses a product comprising instruction means for establishing each one of said plurality of marketplaces in a different computer system (Hennig: column 2, lines 13-28).

Receiving to claim 66. Hennig further discloses a product comprising instruction means for establishing each one of said plurality of marketplaces in a different one of a plurality of computer systems, wherein said plurality of computer systems are coupled together utilizing the Internet (Hennig: column 2, lines 13-28).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 60-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hennig U.S. Patent No. 6,587,827 in view of Arora Patent Application Publication U.S. 2002/0013735.**

Referring to claim 60. Hennig discloses a product according to claim 45 as indicated supra. Hennig does not expressly disclose a product wherein said plurality of marketplaces includes a plurality of different individual on-line auction sites. Arora discloses a product wherein said plurality of marketplaces includes a plurality of different individual on-line auction sites. Arora discloses a product that is used to conduct electronic commerce in specific goods and/or services and in one or more

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market types (Arora: paragraph 0021). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Hennig to have included the limitations of Arora as discussed above because efficient matching of buyers and sellers is essential to create a stable economical model (Arora: paragraph 0022).

Referring to claim 61. Hennig discloses a product according to claim 45 as indicated supra. Arora further discloses a product wherein said instruction means for receiving an order further comprises instruction means for receiving an auction bid (Arora: paragraph 0019).

Referring to claim 62. Hennig discloses a product according to claim 45 as indicated supra. Arora further discloses a product wherein said instruction means for of receiving an order further comprises instruction means for receiving a reverse auction bid (Arora: paragraph 0019).

The Examiner notes, the type of auction (i.e. reverse, multi-sided, call, etc.) qualifies as descriptive material since it is not linked to any specific structure within the claimed invention. The claim is merely concerned with receiving a bid. This descriptive material that will not distinguish the claimed invention from the prior art in terms of patentability.

Referring to claim 63. Hennig discloses a product according to claim 45 as indicated supra. Hennig further discloses a product wherein said instruction means for receiving an order further comprises instruction means for receiving a multi-sided auction bid (Arora: paragraph 0019).

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The Examiner notes, the type of auction (i.e. reverse, multi-sided, call, etc.) qualifies as descriptive material since it is not linked to any specific structure within the claimed invention. The claim is merely concerned with receiving a bid. This descriptive material that will not distinguish the claimed invention from the prior art in terms of patentability.

Receiving to claim 64. Hennig discloses a product according to claim 45 as indicated supra. Hennig further discloses a product wherein said instruction means for receiving an order further comprises instruction means for receiving a call auction bid (Arora: paragraph 0019).

The Examiner notes, the type of auction (i.e. reverse, multi-sided, call, etc.) qualifies as descriptive material since it is not linked to any specific structure within the claimed invention. The claim is merely concerned with receiving a bid. This descriptive material that will not distinguish the claimed invention from the prior art in terms of patentability.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Shkedy, U.S. Patent No. 6,260,024, July 10, 2001, discloses a method and apparatus for facilitating buyer-driven purchase orders on a commercial network system.

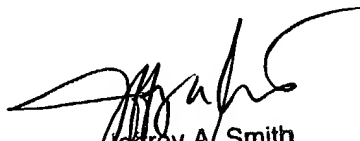
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG  
July 19, 2004



Jeffrey A. Smith  
Primary Examiner